

USSN: 09/560,170Attorney Docket No.: 117-P-1345US01

### Remarks

A cross-reference claiming the benefit of Application Serial No. 09/301,164, filed April 28, 1999 has been inserted at page 1. The '164 application is a prior-filed copending nonprovisional application naming at least two inventors (*viz.*, Bryan M. Anderson and Keith E. Olson) named in the present application. No fee is required under 37 C.F. R. §1.78 in connection with this priority claim because the present application was filed before November 29, 2000 (see 37 C.F. R. §1.78(a)(2)(ii)(B)). There is however a fee for the new independent claims (discussed below).

Claims 20 – 24, 27, 39 and 41 – 51 have been amended to recite a strippable resilient flooring laminate finish system in first and second containers. Claim 41 has been amended to recite a coating comprising water “as a diluent”. Support for these amendments may be found at, e.g., page 4, lines 17 – 18, page 7, lines 25 – 26 and page 8, lines 15 – 24. Claims 25, 26 and 40 have been rewritten in independent form substantially as requested by the Examiner (without claim 20’s objected-to “one or more containers” clause, but including all the limitations of the base claim and any intervening claims), and should be allowable. Following entry of this amendment, claims 1 – 51 will be pending, with claims 1 – 19 and 28 – 38 having been withdrawn from consideration.

This amendment is accompanied by a Declaration of Robert D. P. Hei Under 37 C.F.R. §1.132. Applicants thank the Examiner for extending an in-person interview to the undersigned attorney and Dr. Hei on May 13, 2004. The Examiner’s Interview Summary dated May 13, 2004 and the Declaration collectively summarize the substance of the interview.

### Rejection of Claims 41 – 46 and 49 under 35 USC §112

Claims 41 – 46 and 49 were rejected under 35 USC §112, first paragraph as failing to comply with the written description requirement, on grounds that the written description does not support “a strip agent-permeable polymerizable topcoat comprising water and at least about 15 wt. % solids”. Applicants do not agree with the rejection but in the interest of advancing prosecution have amended claims 41 and 49 to recite “a strip agent-permeable polymerizable topcoat comprising water as a diluent”. This will render the rejection moot. Applicants request that the rejection of claims 41 – 46 and 49 under 35 USC §112, first paragraph be withdrawn.

USSN: 09/560,170Attorney Docket No.: 117-P-1345US01**Rejection of Claims 20 – 27 and 39 – 51 under 35 USC §112**

Claims 20 – 27 and 39 – 51 were rejected under 35 USC §112, second paragraph as being indefinite, on grounds that it was unclear whether the recited intermediate coating and topcoat are in the same or different containers. Applicants have amended claims 20 and 41 to recite an intermediate coating in a first container and a topcoat in a second container. Applicants note for the record that two-component packaging systems in which a first composition is stored in a first chamber of a unitary vessel and a second composition is stored in a second chamber of a unitary vessel are known. Applicants intend that amended claims 20 – 27 and 39 – 51 should be construed literally to cover strippable laminate finish systems in such two-component packaging systems, for at least the reason that such a unitary vessel has a first and second container. Applicants request that the rejection of claims 20 – 27 and 39 – 51 under 35 USC §112, first paragraph be withdrawn.

**Rejection of Claims 20, 22 – 24, 27, 39, 41 – 45  
and 47 – 51 under 35 USC §103(a)**

Claims 20, 22 – 24, 27, 39, 41 – 45 and 47 – 51 were rejected under 35 USC §103(a) as being unpatentable over Published PCT Application No. WO 98/11168 (Hamrock et al.) in view of U.S. Patent No. 6,444,134 B1 (Holman et al.). The Declaration explains that Hamrock et al. do not disclose a waterborne topcoat, such as is recited in claims 20, 22 – 24, 27, 39 or 49 – 51. The Declaration also explains that Hamrock et al. do not disclose a topcoat that comprises water as a diluent, such as is recited in claims 41 – 45 and 47 – 48. The Declaration also explains why a person having ordinary skill in the resilient floor finish art who consulted Hamrock et al. would find reasons **not** to use a waterborne topcoat or a topcoat that comprises water as a diluent in Hamrock et al.'s system.

As also explained in the Declaration, Holman et al. do not describe finishes like those described by Hamrock et al., and do not relate to strippable finishes or to finishes for resilient flooring. There are significant differences in the physical properties and durability of resilient flooring substrates and wood flooring. A person having ordinary skill in the resilient floor finish art who consulted Holman et al. would not use Holman et al.'s renewal finish on resilient

USSN: 09/560,170Attorney Docket No.: 117-P-1345US01

flooring. Holman et al.'s renewal finish is said to have "chemical resistance". The Declaration explains that chemical resistance is **contrary** to strippability and a reason **not** to use Holman et al.'s renewal finish on resilient flooring, and a reason **not** to use Holman et al.'s renewal finish in place of Hamrock et al.'s radiation curable topcoat.

As also explained in the Declaration, 100% solids radiation curable coatings like those described by Holman et al. may have poor spreading or coating characteristics. Some 100% solids radiation curable coatings tend to have a high viscosity and a ridged surface appearance after cure. Such a ridged surface would be unacceptable to end users. 100% solids radiation curable coatings may also be formulated using lower viscosity monomers to reduce the coating viscosity and thereby discourage ridge formation. However, if applied atop a strippable intermediate coating, the cured coating tends to have very uneven gloss (referred to as "diving" and possibly caused by an attack by low viscosity monomers in the topcoat upon the hardened undercoat). A laminate finish that exhibited diving would be unacceptable to end users.

Applicants' laminate finish systems are not shown or suggested by Hamrock et al.'s system and its 100 % solids radiation curable topcoat or by Holman et al.'s chemically resistant wood floor renewal finish. Applicants accordingly request withdrawal of the rejection of claims 20, 22 – 24, 27, 39, 41 – 45 and 47 – 51 under 35 USC §103(a).

#### **Rejection of claim 21 under 35 USC §103**

Claim 21 was rejected under 35 USC §103(a) as being unpatentable over Hamrock et al. in view of Holman et al. and Published PCT Application No. WO 94/22965 (Koreltz et al.). Each of these references is discussed in the Declaration. The Declaration also explains that a person having ordinary skill in the resilient floor finish art would not conclude from Koreltz et al.'s tests stripping CITATION sealant/finish that Koreltz et al.'s stripping agents could be used to remove more durable materials such as Hamrock et al.'s radiation curable topcoat. The Declaration also shows that tests of a Koreltz et al. stripper on two finishes having less strippability and more durability than CITATION sealant/finish and using Koreltz et al.'s 2.5 minute dip test did not demonstrate that the Koreltz et al. stripper is "effective for removing multiple coatings comprising urethane/acrylic polymers" as stated in the Office Action. The Declaration also shows that a highly-durable waterborne UV-crosslinkable topcoat (Finish 4) when applied alone was not

USSN: 09/560,170Attorney Docket No.: 117-P-1345US01

removed using the Koreltz et al. stripper or a more effective stripper (the "Appendix stripper") in a 30 minute strip test but that a laminate finish made by applying Finish 4 over CITATION sealant/finish was completely removed using the Appendix stripper. The Declaration also shows that that a highly-durable two-component aqueous polyurethane topcoat (Finish 5) when applied alone was not removed using the Koreltz et al. stripper or the Appendix stripper, but that a laminate finish made by applying Finish 5 over CITATION sealant/finish could be removed using either stripper. The Declaration demonstrates the advantages of a laminate finish having a waterborne topcoat that is less strippable than the undercoat. Applicants' claim 21 laminate finish system is not shown or suggested by Hamrock et al., Holman et al. or Koreltz et al. Applicants accordingly request withdrawal of the rejection of claim 21 under 35 USC §103(a).

### Conclusion

Applicants have made an earnest effort to overcome the claim objections, and have submitted a Declaration addressing the claim rejections. Hamrock et al. do not teach and in fact teach away from topcoats that are waterborne or that comprise water as a diluent. Holman et al. describe a wood floor refinishing system that is not said to be strippable or suitable for resilient flooring and that is said to be chemically resistant. Koreltz et al. describe strippers for conventional finishes of the type used by applicants as an intermediate coating. Applicants' laminate finish systems are not shown or suggested by Hamrock et al.'s system and its 100 % solids radiation curable topcoat, by Holman et al.'s chemically resistant wood floor renewal finish or by Koreltz et al.'s conventional finish stripper.

Passage of the application to the issue branch is respectfully requested. The Examiner is encouraged to telephone the undersigned attorney if there any questions regarding this application or the Declaration.

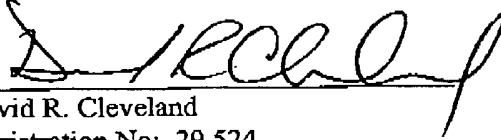
USSN: 09/560,170

Attorney Docket No.: 117-P-1345US01

Respectfully submitted on behalf of  
Ecolab Inc.

June 30, 2004

IPLM Group, P.A.  
P.O. Box 18455  
Minneapolis, MN 55418

  
David R. Cleveland  
Registration No: 29,524  
612-331-7412 (telephone)  
612-331-7401 (facsimile)